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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,598

11/24/2003

Robert Reynolds

BSC-188C1

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22852

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05/05/2009

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EXAMINER

EIDE, HEIDI MARIE

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

05/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/720,598	<b>Applicant(s)</b> REYNOLDS ET AL.	
	<b>Examiner</b> HEIDI M. EIDE	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 38-41, 43-45, 47-51 and 57-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 64 is/are allowed.
- 6) ☒ Claim(s) 38-45, 47, 51, 57-61, 65 and 66 is/are rejected.
- 7) ☒ Claim(s) 48-50, 62 and 63 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Terminal Disclaimer***

The terminal disclaimer filed on February 25, 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,673,080 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-40 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 39 recites the limitation "the cross-section" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 40 recites the limitation "the cross-section" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 58 recites the limitation "the distal joint" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38, 44, 47 and 57-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolgin 5,462,533.

Dolgin teaches a medical device comprising a sheath 12 comprising a proximal and a distal end, a detachable handle 30 (col. 2, ll. 40-42) at the proximal end of the sheath and a basket 110 having a collapsed position when the basket is within the sheath and collapsed and an expanded position when the basket is positioned beyond the distal end of the sheath and expanded (col. 1, ll. 19-25, col. 2, ll. 30-43) wherein the basket in the expanded position is wider at the distal end than at the proximal end (fig. 2), the basket comprising a plurality of wires (2 wires to form the loop form joint 218 to joint 120), a proximal end and a distal end where the distal end of the plurality of wires are joined at a joint 120, comprising a tip member, configured to fail when a first predetermined force is applied to the joint, the distal ends of the plurality of wires releasing from each other (fig. 3) when the joint fails, the first predetermined force being less than both a force required to cause one of the plurality of wires to fail and a force required to cause the proximal end of the basket to fail (col. 3, ll. 25-30). The device of Dolgin further operates such that the distal joint applies a retention force of the plurality of wires, the plurality of wires applies a tension force on the distal joint when force is applied to the basket and the tension force exceeds the retention force when the force applied to the basket exceed the first predetermined force, which in turn causes the distal joint to break (col. 3, ll. 25-35).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-41 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolgin 5,462,533 as applied to claim 38 above, and further in view of Bates 5,944,728. Dolgin teaches the invention as discussed above, however, does not teach the distal end of at least one wire is scored and wherein the cross section of at least one of the plurality of wires is D-shaped or V-shaped or the wire comprises stainless steel. Bates teaches the "inner surface of the legs can comprise a surface that is rougher than the outer surface, and this roughness can comprise, for example, a serrated surface, a toothed surface of an etched surface" (see col. 2, lines 35-38). An etched surface is considered to be scored. It would have been obvious to one having ordinary skill in the art at the time the invention was made to score at least one wire or leg of the basket as taught by Bates in order to enhance stone capture and retention. Bates further teaches the cross section of at least one of the plurality of wires is D-shaped or V-shaped (col. 5, ll. 49-54) and the wires are made of stainless steel (col. 5, ll. 1-2). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dolgin in view of Bates since it has been held that the configuration of the claimed wire was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed wire

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was significant (*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) MPEP 2144.04 IV B) and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) MPEP 2144.07).

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dolgin 5,462,533 as applied to claim 38 above, and further in view of Okada et al. 5,059,199 (Okada). Dolgin teaches the invention as discussed above, however, does not teach each of the plurality of wires comprises four bends. Okada teaches the wires comprise four bends (fig. 2). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dolgin in view of Okada in order to further extend the basket to trap a greater stone as taught by Okada (col. 5, ll. 19-25).

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dolgin 5,462,533. Dolgin teaches the claimed invention as discussed above, however, does not teach the radial stiffness of at least one wire is greater than 0.7 g/mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use wires with a stiffness value that would render the wires capable of retrieving stones including a value greater than 0.7g/mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 51, 61 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolgin 5,462,533 as applied to claims 38 and 59 above, and further in view of Schnell et al. 4,467,930 (Schnell). Dolgin teaches the invention as discussed above, however, does not teach the distal joint comprises at least one of a weld joint, an overmolding joint, an adhesive joint or a solder joint. Schnell teaches a frangible joint which is formed by overmolding (col. 5, ll. 37-44). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dolgin in view of Schnell as a matter of obvious design choice since Schnell teaches a known method of forming frangible joints.

#### ***Allowable Subject Matter***

Claim 64 allowed.

Claims 48-50, 62-63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEIDI M. EIDE whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Heidi Eide**  
**Examiner**  
**Art Unit 3732**

/Heidi M Eide/  
Examiner, Art Unit 3732

5/1/2009

/Cris L. Rodriguez/  
Supervisory Patent Examiner, Art Unit 3732